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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,654	04/14/2004	Yoshio Terada	Q81096	4963
65565	7590	02/03/2010	EXAMINER	
SUGHRUE-265550			DOUYON, LORNA M	
2100 PENNSYLVANIA AVE. NW			ART UNIT	
WASHINGTON, DC 20037-3213			PAPER NUMBER	
			1796	
			NOTIFICATION DATE	
			DELIVERY MODE	
			02/03/2010	
			ELECTRONIC	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/823,654

**Applicant(s)**

TERADA ET AL.

**Examiner**

Lorna M. Douyon

**Art Unit**

1796

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 January 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5,8,9,11-16,20 and 23 is/are pending in the application.
- 4a) Of the above claim(s) 11-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5,8,9,20 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 20, 2010 has been entered.
2. Claims 5, 8-9, 11-16, 20 and 23 are pending. Claims 11-16 are withdrawn from consideration as being drawn to a nonelected invention. Claims 5 and 8 are currently amended.
3. The rejection of claims 5, 8-9, 20 and 23 under 35 U.S.C. 103(a) as being unpatentable over Terada et al. (WO 03/052045) is withdrawn in view of Applicants' amendment.

***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 5, 8-9, 20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Terada et al. (WO 03/052045), hereinafter "Terada" in view of Namikawa et al. (WO 02/05975), hereinafter "Namikawa".

Terada teaches a cleaning label which comprises a cleaning layer **3** and a release film **4** provided on one side of a backing **2** and an ordinary adhesive layer **5** provided on the other side of the backing **2** and is peelably provided on the separator **1** with this adhesive layer **5** interposed therebetween; and in operation, the cleaning label is peeled off the separator **1**, and then stuck to a conveying member such as semiconductor wafer (see page 29, lines 9-23, Figures 1 and 2). The cleaning layer is not specifically limited in its material, however, a material which has cured by an activation energy source such as ultraviolet rays and heat to have a three-dimensionally networked molecular structure that gives a lowered adhesion is preferably used, for example, the 180° peel adhesion with respect to silicon wafer is 0.20 N/10 mm or less (see page 19, line 24 to page 20, line 8; page 27, lines 13-16). The tensile modulus of the cleaning layer is 10 MPa or more (see page 20, line 25 to page 21, line 3; page 31, lines 6-9). The cleaning layer comprises a compound having one or more unsaturated double bonds per molecule incorporated in a pressure-sensitive adhesive polymer is preferred (see page 21, lines 15-18). Example of such pressure-sensitive adhesive polymer is an acrylic polymer comprising as a monomer a (meth)acrylic acid and/or (meth)acrylic acid ester (see page 21, lines 19-22). The backing for the cleaning layer is not specifically limited. (see page 24, lines 18-21). The release film (i.e., protective film) is treated with a silicone-based releasing agent and is laminated as a separator,

wherein the amount of silicone attached to said cleaning layer when the separator is peeled off said cleaning layer is  $0.005 \text{ g/m}^2$  or less as calculated in terms of polydimethylsiloxane (see page 6, line 19 to page 7, line 9; page 8, lines 13 to page 10, line 21). The release film to be used in the protection of the cleaning layer may be a film made of polyethylene, polypropylene, polybutene, polybutadiene or polymethylpentene (see page 27, lines 21-24), which has been release-treated with a silicone-based releasing agent, a long-chain alkyl-based releasing agent, a fluorine-based releasing agent, an aliphatic acid amide-based releasing agent or a silica-based releasing agent (see page 28, lines 4-8). Terada, however, fails to specifically disclose a cleaning layer comprising a polyimide resin, wherein each of the relative intensities of the recited fragment ions in the cleaning layer, when the protective film is peeled off the cleaning layer, is 0.1 or less.

Namikawa, an analogous art, teaches that a cleaning layer is not particularly limited, and as particular examples, in addition to the material obtained by causing the compound, that has one unsaturated double bond or more in the molecule, to contain into the pressure-sensitive adhesive polymer, there may be employed preferably rubbers, natural resins, synthetic resins such as polyethylene terephthalate, phenol resin, polyester resin, alkyd resin, epoxy resin, polycarbonate, cellulose nitrate, poly(vinylidene fluoride), polypropylene, polyimide, nylon 6, nylon 66, poly(methyl methacrylate), methyl methacrylate/styrene copolymer, ethylene fluoride/propylene copolymer, etc. (see page 5, line 19 to page 6, line 8).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have substituted the cleaning layer comprising (meth)acrylic acid of Terada with a cleaning layer comprising polyimide resin because the substitution of art recognized equivalents as shown by Namikawa is within the level of ordinary skill in the art. In addition, simple substitution of one known element for another would achieve the predictable result of providing an effective cleaning layer which causes no contamination on the conveying site. In addition, it would also have been obvious to one of ordinary skill in the art at the time the invention was made to reasonably expect each of the relative intensities of the recited fragment ions in the cleaning layer, when the protective film is peeled off the cleaning layer, to be within those recited, i.e., 0.1 or less, because Terada teaches on page 6, line 19 to page 7, line 9; page 8, lines 13 to page 10, line 21 that the amount of silicone attached to said cleaning layer when the separator is peeled off said cleaning layer is  $0.005 \text{ g/m}^2$  or less, as calculated in terms of polydimethylsiloxane, hence, such amount would be equivalent to those recited.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

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F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 5, 8-9, 20 and 23 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 14 of U.S. Patent No. 7,575,790 in view of Namikawa.

US '790 teaches a carrying member with a cleaning function, comprising a carrying member and a cleaning sheet as those recited except for the cleaning layer comprising polyimide resin, wherein each of the relative intensities of the recited fragment ions in the cleaning layer, when the protective film is peeled off the cleaning layer, is 0.1 or less.

Namikawa teaches the features as described above.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have prepared the cleaning layer of US '790 with a cleaning layer comprising polyimide resin because it is known from Namikawa that a cleaning layer in a similar product comprises polyimide resin which no contamination on the conveying site. In addition, it would also have been obvious to one of ordinary skill in the art at the time the invention was made to reasonably expect each of the relative

intensities of the recited fragment ions in the cleaning layer, when the protective film is peeled off the cleaning layer, to be within those recited, i.e., 0.1 or less, because US '790, in claim 10 states that the amount of silicone attached to said cleaning layer when the separator is peeled off said cleaning layer is  $0.005 \text{ g/m}^2$  or less, as calculated in terms of polydimethylsiloxane, hence, such amount would be equivalent to those recited.

### ***Response to Arguments***

8. Applicants' arguments with respect to claims 5, 8, 9, 20 and 23 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references are considered cumulative to or less material than those discussed above.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to 3 whose telephone number is 571-272-1313. The examiner can normally be reached on Mondays-Fridays 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lorna M Douyon/  
Primary Examiner, Art Unit 1796